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DEC 05 2011

In re Application of	:	OFFICE OF PETITIONS
Balazs et al.	:	
Application No. 10/577,177	:	
Filed: February 5, 2007	:	ON APPLICATION FOR
Attorney Docket No.	:	PATENT TERM ADJUSTMENT
C1233.70001US01	:	
Title: METHODS FOR PURIFYING	:	
HEMATOPOIETIC STEM CELLS	:	
	:	

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT" filed November 17, 2011. Applicants request that the determination of patent term adjustment be corrected from one hundred thirty-one (131) days to six hundred forty-six (646) days.

As the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is **DISMISSED as PREMATURE.**

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e) for consideration of the application for patent term adjustment under 37 CFR 1.705(b).

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under §

1.702(a)(4) or applicant delay under § 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office cannot make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for continued examination) is premature. Accordingly, it is appropriate to dismiss as premature such a request.

Rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, applicant is advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicant must timely file an application for patent term adjustment prior to the payment of the issue fee¹.

To the extent that applicant otherwise requests reconsideration of the patent term adjustment at the time of the mailing of the

¹ For example, if applicant disputes both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicant must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the §1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.

notice of allowance, the application for patent term adjustment is **DISMISSED** to the extent indicated herein.

On September 8, 2011, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment to date is 131 days. The instant application for patent term adjustment was timely filed on November 17, 2011.

Applicants' calculations include a 228 day adjustment for the delay in mailing the Notice of Allowance of September 8, 2011 in response to the September 24, 2010 request for continued examination (RCE) and amendment.

The Office has concluded that an adjustment of 227 days was properly entered based on 37 CFR 1.702(a)(2). 37 CFR 1.702(a)(2) provides that:

Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to:

Respond to a reply under 35 U.S.C. 132 or to an appeal taken under 35 U.S.C. 134 not later than four months after the date on which the reply was filed or the appeal was taken;

In this instance, the Office took until September 8, 2011 to mail the Notice of Allowance in response to the RCE and amendment filed September 24, 2010. Pursuant to 37 CFR §1.703(a)(2), a period of adjustment of two hundred twenty-seven (227) days, counting the number of days in the period beginning on the day after the date that is four months after the date a reply was filed, January 25, 2011, and ending on the date of mailing of the Notice of Allowance September 8, 2011, should have been entered.

Applicants' delay prior to the mailing of the Notice of Allowance is 172 days. Office delay prior to the mailing of the Notice of Allowance is 303 days.

In view thereof, the correct patent term adjustment at the time of the mailing of the notice of allowance is 131 days.

Any request for reconsideration of the patent term adjustment indicated on the patent must be timely filed within 2 months after issuance pursuant to 37 CFR 1.705(d) and **must** include payment of the required fee under 37 CFR 1.18(e).

The Office of Data Management has been advised of this decision. This application is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3215.

A handwritten signature in black ink, appearing to read "Charlema Grant", with a stylized flourish at the end.

Charlema Grant
Attorney Advisor
Office of Petitions